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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,187	04/26/2001	Thomas M. Baer		2124

7590 04/05/2005
Rimas Lukas
465 Kelly Ave., #E
Half Moon Bay, CA 94019

EXAMINER

CROSS, LATOYA I

ART UNIT PAPER NUMBER

1743

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/844,187

Applicant(s)

BAER ET AL.

Examiner

LaToya I. Cross

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 79-82 and 93-108 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-13, 79-82, 94-96, 101-103 and 105-108 is/are allowed.
- 6) ☒ Claim(s) 1-4, 93, 97-100 and 104 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on March 21, 2005 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

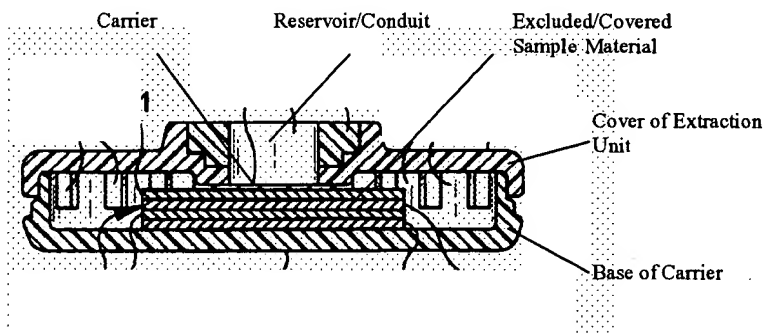
3. Claims 1-4, 93, 97-100 and 104 are rejected under 35 U.S.C. 102(b) as being anticipated by US patent 6,057,165 to Mansour.

Mansour teaches an assay device for collecting and testing biological samples. The device comprises a base (45) having a composition material (41) onto which a biological sample is disposed. The base having the biological sample is considered to be a “carrier” . The carrier mates with a cover portion (46). The cover portion has an aperture (48), which is a conduit running from the top of the cover to the bottom of the cover. When the cover is mounted onto the base, the sample

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carrier closes the bottom part of the conduit and forms a reservoir. The portions of the carrier on both sides of the conduit are not in communication with the conduit. In fact a part of the cover covers a portion of the carrier and excludes a part of the carrier from being in communication with the conduit. See figure 5 labeled below. Mansour further teaches that a well (10) may be mated with cover at the conduit for delivering fluids into the conduit (col. 12, lines 1-7).

It is noted that Mansour do not disclose the cover having the conduit as an extraction unit. However, in the claims the extraction unit is defined as having a carrier receiving portion and a conduit extending between a first opening and a second opening of the carrier-receiving portion. Since Mansour teach such, the claim limitations are met.



Allowable Subject Matter

4. Claims 5-13, 79-82, 94, 95, 96, 101-103 and 105-108 are allowed.

The prior art of record fails to teach or fairly suggest an extending feature or stand-off portion on the carrier. The prior art of record also fails to teach or suggest a transfer film on the carrier. Transfer film has been interpreted in light of the specification as a film adapted for absorbing

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energy delivered by a laser pulse or multiple laser pulses and further adapted for expanding and adhering to the target cells (specification page 10, paragraph 52). Further, the prior art of record fails to teach or suggest a method for extracting matter wherein a carrier having a transfer film is mated to an extraction device.

Response to Arguments

5. Applicant's arguments filed on March 21, 2005 have been fully considered but they are not persuasive.

With respect to the anticipation rejection over Mansour, Applicants argue that the reference fails to teach that the carrier closes the first opening, seals the opening to prevent fluid flow and forms a reservoir. It should be noted that the claims recite that the carrier-receiving portion, not the carrier, functions in this manner. In response to Applicants' argument, the Examiner would like to point out that such limitation is functional. While the limitation is considered, the limitation does not limit the claims sufficiently to distinguish the present invention over the device disclosed in Mansour. Since the claims are directed to an apparatus, the claims must define a device that is structurally different from that disclosed in Mansour. Further, the Examiner notes that the claims are not clear as to what fluid flow is being prevented. Page 16 of the specification states that the transfer film (28) closes inner opening (72) and forms a reservoir (92) with conduit (70). Is the fluid on the transfer film being prevented from flowing? Or does the carrier-receiving portion prevent fluid flow inside the conduit?

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With respect to claim 99, Mansour teaches that a well (of a microtiter plate) may be mated with the cover at the conduit for delivering fluids into the conduit (col. 12, lines 1-7).

With respect to the reasons for allowance, Applicants argue that the Examiner's interpretation of "transfer film" is unduly restricted. In response, the Examiner notes that Applicants provide only one definition of transfer film (specification page 10, paragraph 52). Thus, the phrase has been given the definition that Applicants give in their specification.

With respect to the finality of the previous Office Action, Applicants argue that no information disclosure statement was filed and the Examiner gave a new ground of rejection, using a newly cited reference. The new ground of rejection given in the Final rejection was in response to Applicants' claim amendments. Since Applicants' amendments necessitated the new ground of rejection, the finality of the office action is proper. See MPEP 706.07(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is 571-272-1256. The examiner can normally be reached on Monday-Friday 8:30 a.m. - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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M. J. Cole
Monique T. Cole
Primary Examiner
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